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10-01-02 2165

PATENT
Customer No. 22,852
Attorney Docket No. 6556.0039

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John POLK et al.

Application No.: 10/043,493

Filed: January 14, 2002

For: APPARATUS AND METHODS
FOR PROVIDING A PAYMENT
SYSTEM OVER A NETWORK

)
)
) Group Art Unit: 2165
)
) Examiner: Not yet assigned
)
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Commissioner for Patents
Washington, DC 20231

Sir:

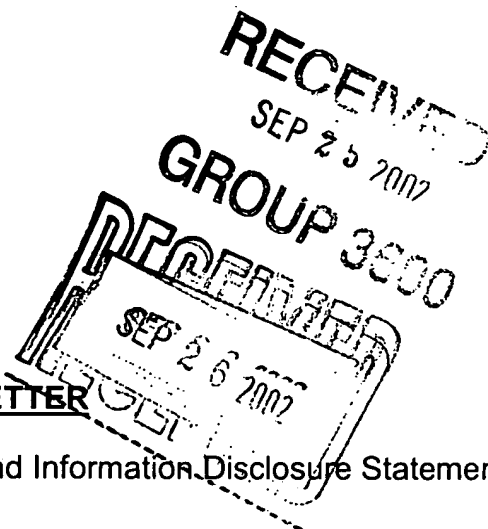
TRANSMITTAL LETTER

Enclosed is a Notice of Related Litigation and Information Disclosure Statement
Under 37 C.F.R. § 1.97(b).

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Dated: September 20, 2002

By: Robert E. Converse, Jr.
Robert E. Converse, Jr.
Reg. No. 27,432



FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com



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Sir:

NOTICE OF RELATED LITIGATION

Pursuant to 37 C.F.R. § 1.56, as clarified by § 2001.06(c) of the Manual of Patent Examining Procedure, Applicants hereby notify the Examiner that U.S. Patent No. 6,119,107 ("the '107 patent") and U.S. Patent No. 5,946,669 ("the '669 patent") are the subject of a litigation in the United States District Court for the District of Minnesota (Civ. Action No. 02-CV-1231 DWF/SRN) between plaintiff Pay Child Support Online Inc. against defendant ACS State & Local Solutions, Inc. The plaintiff's Complaint is attached as Exhibit A. Defendant (and counter-plaintiff) ACS State & Local Solutions, Inc.'s Answer and Counterclaim is attached as Exhibit B.

Application no. 08/941,187 ("the '187 application"), filed September 30, 1997, matured into the '669 patent. Divisional application no. 09/003,941 ("the '941

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

application"), filed January 7, 1998, resulted from the '187 application and matured into the '107 patent. Although the present application is not directly related to the '107 patent or the '669 patent, Applicants provide this Notice because the technology is related and the present application shares an inventor in common with the patents-in-suit.

In this dispute, the plaintiff has alleged inter alia, albeit without support, that the '107 and the '669 patents are invalid under § 102(a) and (b), although it is not clear from the Complaint what particular art the plaintiff relies upon. Further, the plaintiff alleges, without support, that the '107 and the '669 patents are invalid under § 102(f) "as the transfer of Child Support Payments Nationally would not have been possible without the creation of the Child Support Application Banking Convention developed with Federal Funds and adopted by the National Automated Clearing House Association and DISA." The plaintiff also alleges, without support, that the '107 and the '669 patents are invalid under § 102(g) because "the claims of the patent were already in use in this country by others, including multiple state agencies."

The plaintiff further alleges, without support, that the invention is not unique and is obvious to all skilled in the art. However, the Complaint does not specifically identify any basis for this allegation.

Finally, the Complaint alleges, again without support, that the '107 and the '669 patents are unenforceable due to inequitable conduct due to an intentional failure to disclose pertinent information to the U.S. Patent and Trademark Office during prosecution of the '941 and '187 applications, as well as a bald complaint of patent misuse. The allegedly pertinent information, which defendant (and counter-plaintiff) was

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

allegedly aware of and did not disclose, is being submitted in an Information Disclosure Statement filed concurrently with this Notice of Related Litigation.

In the counterclaim, defendant/counter-plaintiff alleges, among other causes of action, willful infringement of the '669 patent and willful infringement of the '107 patent by plaintiff/counter-defendant. Notably, the plaintiff/counter-defendant admits infringement in the Complaint.


Applicants will continue to keep the PTO informed of further developments in this related litigation.

If there is any fee due in connection with the filing of this Notice, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 20, 2002

By: 
Robert E. Converse, Jr.
Reg. No. 27,432

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HENDERSON
FARABOW
GARRETT &
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